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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,265	01/21/2004	Kia Silverbrook	SMA10US	1040
24011 7590 10/16/2008 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER ANTONIENKO, DEBRA L	
			ART UNIT 3689	PAPER NUMBER
			MAIL DATE 10/16/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/760,265

Applicant(s)

SILVERBROOK ET AL.

Examiner

DEBRA ANTONIENKO

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a Final Office Action in response to communications received June 12, 2008, wherein:

Claim 1 has been amended;

Claim 3 has been cancelled; and

Claims 1, 2, 4-11 are pending.

Response to Amendment

2. Amendment to the Abstract is sufficient to overcome the objection set forth in the previous Office Action (March 27, 2008).

3. Amendment to the Specification in replacing the docket numbers with the application/patent numbers is sufficient to overcome the objection set forth in the previous Office Action. However, the second statement on page 2 following the table – "The above applications have been identified by their filing docket number, which will be substituted..." – is no longer appropriate.

4. Amendment to the Drawing is sufficient to overcome the objection set forth in the previous Office Action.

5. The terminal disclaimer filed on June 12, 2008 with respect to U.S. Patent Number 7,002,664 has been recorded.

6. Cancellation of Claim 3 is sufficient to overcome the 35 U.S.C. 101 rejection set forth in the previous Office Action.

7. Removal of the phrase "in a manner" in Claim 1 is sufficient to overcome the 35 U.S.C. 112 (2) rejection set forth in the previous Office Action.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 2, 4-11 recite the limitation "print media." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto et al., U.S. Patent Number 5,974,401 (hereinafter referred to as Enomoto) in view of Wen, U.S. Patent Number 6,109,745 (hereinafter referred to as Wen).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Regarding Claim 1:

Enomoto teaches a method of operating a photofinishing business comprising utilizing a digital photofinishing system that incorporates a digital processor, a printer coupled to the digital processor, and means for feeding plain paper to the printer from a roll of the plain paper...(column 2, lines 23-31; column 5, lines 8-12; Figure 2, element 31);

Enomoto does not explicitly teach the use of plain paper. However, Enomoto teaches the use of a variety of printers depending on what type of print the customer orders. Enomoto teaches the use of a *well-known ink jet type color digital printer* (column 5, lines 43-52). It would have been obvious to one of ordinary skill in the art at the time of the invention to use plain paper in an ink jet printer in order to fulfill the customer's print order.

...providing the digital processor with digitised data from a source that is provided by a customer, and which is representative of a photographic image; processing the data with the digital processor to generate a printer drive signal that is representative of the photographic image (column 1, lines 54-67 and column 2, lines 1-5);

...of the photographic image on the plain paper as it is fed directly to the printer from the roll, by the feeding means (column 5, lines 8-18 and 42-44; Figure 2, element 31);

and furnishing the printed plain paper image to the customer and charging the customer for the printing service (column 2, lines 43-45). Enomoto teaches calculating the print charge and delivery date.

Enomoto does not explicitly teach in response to the drive signal effecting page-width printing.

However, Wen does disclose the drive signal being processed to effect page-width printing (column 2, lines 35-38 and 44-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Enomoto's system to incorporate Wen's page-width printing in order to maximize the speed of printing.

12. Claims 2, 4-6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Wen and further in view of Tanaka, U.S. Patent Number 6,196,493 (hereinafter referred to as Tanaka).

Regarding Claim 2:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Enomoto and Wen do not explicitly teach wherein the roll of print media is provided by way of a replaceable cartridge.

However, Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (column 4, lines 18-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Wen with that of Tanaka to incorporate a replaceable cartridge in order to facilitate installing and replacing the print media.

Regarding Claim 4:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Enomoto and Wen do not explicitly teach wherein the roll of print media is provided by way of a replaceable cartridge in which the cartridge is mounted removably in juxtaposition to the printer and comprises a roll of the print media to be fed on demand to the printer, and the cartridge incorporates means for coupling with a print media feed drive mechanism.

However, Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2) in which the cartridge is mounted removably in juxtaposition to the printer (column 5, lines 50-54; Figure 6, elements 10 and 30) and comprises a roll of the print media to be fed on demand to the printer, and the cartridge incorporates means for coupling with a print media feed drive mechanism (column 4, lines 32-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Wen with that of Tanaka to locate the print media next to the printer in order to minimize the transport time and exposure of print media before being printed.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Wen with that of Tanaka to incorporate a media feed drive mechanism in order to facilitate the printing process.

Regarding Claim 5:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Wen further teaches a source of printing fluid to be delivered on demand to the printer (column 2, lines 20-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Enomoto's system to incorporate Wen's supply of printing fluid in order to facilitate the printing process.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge in which the cartridge is mounted removably in juxtaposition to the printer ... and the cartridge incorporates means for coupling with a print media feed drive mechanism (see Claim 4).

Regarding Claim 6:

See Claims 4 and 5.

Regarding Claim 9:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Enomoto and Wen do not explicitly teach wherein the roll of print media is provided by way of a replaceable cartridge in which print media feed means are located in the cartridge and drive means couple with the print media feed means to effect feeding of the print media through the printer.

However, Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge in which print media feed means are located in the cartridge and drive means couple with the print media feed means to effect feeding of the print media through the printer (see Claim 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Wen with that of Tanaka to locate print media feed means in the cartridge in

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order to facilitate the printing process.

13. Claims 7, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Wen in view of Tanaka and further in view of Janosky et al., U.S. Patent Number 6,394,669 (hereinafter referred to as Janosky).

Regarding Claim 7:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2).

Enomoto, Wen, and Tanaka do not explicitly teach in which a drier means is coupled to the printer and the drier means receives printed media directly from the printer, to transport the printed media from the printer and to effect drying of the printed media during transportation of the media.

However, Janosky discloses in which a drier means is coupled to the printer and the drier means receives printed media directly from the printer, to transport the printed media from the printer and to effect drying of the printed media during transportation of the media (column 7, lines 20-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto, Wen, and Tanaka with that of Janosky to incorporate a drier in order to facilitate the printing process.

Regarding Claim 8:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2).

Enomoto, Wen, and Tanaka do not explicitly teach in which a slitter means is located in series with the printer and the slitter means receives printed media following its passage through the printer, transports the printed media in a direction away from the printer and slits the printed media in the longitudinal direction of transportation of the media.

However, Janosky discloses in which a slitter means is located in series with the printer and the slitter means receives printed media following its passage through the printer, transports the printed media in a direction away from the printer and slits the printed media in the longitudinal direction of transportation of the media (column 8, lines 58-67; column 9, lines 1-2; Figure 5A).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto, Wen, and Tanaka with that of Janosky to incorporate a slitter in order to efficiently provide the required print size.

Regarding Claim 10:

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Enomoto and Wen teach the limitations of Claim 1 as described above.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2).

Enomoto, Wen, and Tanaka do not explicitly teach in which means are provided to enable chemical development and subsequent printing of exposed photographic film.

However, Janosky discloses in which means are provided to enable chemical development and subsequent printing of exposed photographic film (column 3, lines 59-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto, Wen, and Tanaka with that of Janosky to provide development and printing of photographic film as well in order to accommodate customer needs.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Wen in view of Tanaka and further in view of Silverbrook et al., U.S. Patent Number 6,612,240 (hereinafter referred to as Silverbrook).

Regarding Claim 11:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2).

Enomoto, Wen, and Tanaka do not explicitly teach in which the printer incorporates at least one print head assembly that is arranged to provide for printing of the print media with a feed rate up to 2 metres per second.

However, Silverbrook discloses in which the printer incorporates at least one print head assembly that is arranged to provide for printing of the print media with a feed rate up to 2 metres per second (column 2, lines 7-9; Figure 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto, Wen, and Tanaka with that of Silverbrook to include a print head assembly and to determine the feed rate in order to facilitate the printing process.

Response to Arguments

15. Applicant's arguments filed June 12, 2008 have been fully considered but they are not persuasive.

Regarding Claim 1: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (e.g., using plain paper) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant is arguing newly claimed limitations which have been addressed in the action above.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689

